



**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

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## **COMMUNICATION**

Attention: Office of Petitions  
Mail Stop Petition  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

Enclosed is a Petition for Revival of an Application for Patent Abandoned Unintentionally Under 37 CFR 1.137(b), together with our check in the amount of \$685.00 to cover the Petition fee for a small entity. Included in the Petition for Revival is a statement establishing unintentional delay. Since the application was filed after June 8, 1995, no Terminal Disclaimer is required.

Please charge any additional fees concerning this matter or credit any overpayment to our  
Deposit Account No. 15-0508.

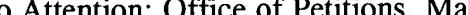
Respectfully submitted,

By Michael A. Hierl, Reg. No. 29,807

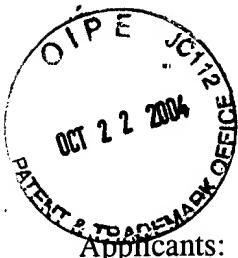
**OLSON & HIERL, LTD.**  
20 North Wacker Drive, 36th Floor  
Chicago, Illinois 60606  
(312) 580-1180

**CERTIFICATE OF MAILING**

I hereby certify that this paper is being deposited with the U.S. Postal Service with sufficient postage as First Class Mail in an envelope addressed to Attention: Office of Petitions, Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on October 19, 2004.



  
Michael A. Hierl



**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicants: Greenwood, et al. ) Group Art Unit: 1744  
                                      )  
Serial No.: 09/834,101           ) Examiner: Chin, Randall E.  
                                      )  
Filed: April 12, 2001           ) Confirmation No.: 5324  
                                      )  
For: Detachably Interconnected Handle ) Atty Docket: MHG-05  
                                      and Paint Brush                   )  
                                      )

**PETITION FOR REVIVAL OF AN APPLICATION FOR PATENT  
ABANDONED UNINTENTIONALLY UNDER 37 CFR 1.137(b)**

Attention: Office of Petitions  
Mail Stop Petition  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

This Petition for Revival is submitted together with a check in the amount of \$685.00 (Check No. 026565) to cover the Petition fee for a small entity. However, applicants respectfully submit that the abandonment of this application has occurred through circumstances within the PTO that are unknown to, and beyond the control of, applicants. As a result, applicants respectfully request that the foregoing petition fee be refunded and credited to Deposit Account No. 15-0508.

A Decision was mailed by the PTO on August 19, 2004 dismissing applicants' Petition to the Director under 37 CFR §1.181 Requesting Withdrawal of, or Relief from, Examiner's Species Election Requirement submitted on October 15, 2003 (herein "Petition to Withdraw Species Election"). The Petition to Withdraw Species Election was filed in response to the outstanding Office Action of September 25, 2003. No decision has been received on the Petition to Make Special under 37 CFR §1.102(d) (herein "Petition to Make Special") which was filed concurrently

with the Petition to Withdraw Species Election on October 15, 2003. A Notice of Abandonment was mailed by the PTO on October 4, 2004.

In accordance with the Rules of Practice, applicants and undersigned counsel state and respectfully maintain that, with respect to them, the entire failure to file a timely and proper response to the outstanding Office Action in this application and in filing this Petition to Revive was unintentional.

Also, in accordance with the Rules of Practice, applicants and undersigned counsel submit and respectfully maintain that the Petition to Withdraw Species Election fully complied with §818.03 (to the extent applicable) of the Manual of Patent Examining Procedure (MPEP), these sections being cited in the above-referenced Decision.

The 10 page Petition to Withdraw Species Election was carefully prepared and is believed to fully comply with all applicable Rules of Practice and applicable language of the MPEP. The document is captioned a "Petition" but the language and position expressed therein qualifies the document as a full and complete response to the outstanding Office Action mailed September 25, 2003. Surely the PTO still remains more substance oriented than form oriented. Thus, in the language of MPEP §808.03(a) (cited in the Decision), the Petition to Withdraw Species Election is a "complete reply" which is duly "reduced to writing" which "specifically points out the supposed errors in the examiner's action" and which replies "to every ground of objection and rejection in the prior Office Action." Applicants and undersigned counsel earnestly submit that this "reply . . . appear[s] throughout to be a bona fide attempt to advance the application. . . ." The document

specifically and at length "point[s] out the reasons on which . . . [the] . . . conclusions that [the] . . . requirement to restrict . . . is in error. . ." The remarks in the Petition are clearly far more specific and detailed than "[a] mere broad allegation that the requirement is in error" . . . [and] . . fully comply with the requirement of 37 CFR §1.111. Thus the required provisional election (see MPEP §813.03(b)) becomes an election without traverse."

The Petition twice asks that the requirement in the Office Action be "reconsidered and withdrawn" (see the Petition at page 3, line 17 and at page 10, lines 5-6). Although applicants take the position that the Petition as filed was and is a full and complete response to the Office Action, if the USPTO chooses to regard the Petition as something other than a full and complete response to the Office Action, then applicants will refile the Petition with a different heading such as: "Response to Office Action of September 25, 2003." The fact that the Decision states that the Petition is "dismissed" seems to ignore the fact that the Petition is, and remains, fully of record in this application even after entry of the Decision particularly since the word "dismissed" does not mean that the Petition is expunged from the record. It seems, rather, that, under the Rules of Practice and the MPEP, the Decision only effectively "Denied" the Petition. The Decision in effect did not recognize that the Petition was a full and complete response to the Office Action.

There seems to be confusion in the above-identified Decision regarding just what was involved in the Examiner's Office Action. That Office Action related to a species election requirement, not a restriction requirement, and the Petition to Withdraw Species Election specifically requested that the Examiner's species election requirement be reconsidered and withdrawn. MPEP §818 as cited in the Decision relates to restriction requirements, not species

election requirements. For example, 37 CFR §143 which cited in MPEP §818.03(4) and which is quoted in the Decision relates to restriction. Rule 143 provides that an applicant may disagree with the requirement for restriction and may request reconsideration and withdrawal or modification of the requirement giving reasons. The second sentence of Rule 143 reads:

"In requesting reconsideration the applicant must indicate a provisional election of one invention for prosecution, which invention shall be the one elected in the event that the requirement becomes final."

Note that the Rule language does not state that the applicant must elect a restricted invention identified by the Examiner; there is no reason based on the language of the Rule why the elected invention must be one which the Examiner specifies. The PTO may maintain otherwise, but that is not what the Rule says. The Petition is consistent with the express language of the Rule. Also, there is nothing in this Rule, nor in accompanying Rules 141, 142 or 144 (37 CFR §§ 1.141, 1.142 and 1.144) which relates to an election of species.

Species election is dealt with in Rule 146 (37 CFR 1.146) and in MPEP §§806.04(a) - 806.04(f). For example, contrary to the Examiner's statement that "no claim is generic" (page 2 of September 25, 2003 Office Action), various claims as originally filed in the present application are clearly generic. For instance, claims 1 and 3 are generic because they (read on) structures shown in all 50 Figures of the present application. Also, the generic claim such as claims 1 and 3 completely satisfy the definition of a generic claim as set forth in MPEP 806.04(d) which, *inter alia*, states:

"In general, a generic claim should include no material element additional to those recited in the species claims, and must comprehend within its confines the organization covered in each of the species." (MPEP at page 800-41)

In the Office Action, the Examiner specifically identifies 10 alleged "patentably distinct species of the claimed invention" and 4 alleged "patentably distinct sub-species" (pages 2 and 3 of September 25, 2003 Office Action). In the Petition to Withdraw Species Election, applicants detail and identify various embodiments and features shown in the Figures and show that the 10 alleged species and 4 alleged sub-species selected by the Examiner is essentially an arbitrary selection from among multiple various disclosures in the drawings and the specification of the present application. In good faith, applicants point out and explain in the Petition that selecting one particular species from among the 10 species and 4 alleged sub-species selected by the Examiner would or could prevent them from obtaining meaningful and enforceable generic claim coverage on at least some commercially meaningful aspect of their invention.

This invention does not relate to a complex machine, but rather to an improvement in a relatively simple paint brush. Separating the simple paint brush into many allegedly independent species not only seems ludicrous, but also limits the generic scope of the invention from a patent standpoint.

Under MPEP §806.04(h), it appears that the 10 species selected by the Examiner are not patentably distinct from each other. Species election should not be required if the species are unpatentable over each other. The Examiner has not explained at all how and why the individual ones of these selected species are "patentably distinct species of the claimed invention" as merely alleged in the Office Action.

For record purposes, it is noted that applicants respectfully object to making an species election from among 10 allegedly independent species, as requested by the Examiner, because such

an election creates an undesirable file wrapper record that would possibly adversely affect their ultimately granted enforceable patent rights particularly under *Festo* and certain recent federal court decisions, as surely the USPTO must know and readily appreciate. So far as known, by objecting to the Examiner's request for species election from among 10 specified species, and by not identifying a single species among the 10 species, applicants have not violated any Rule of Practice or MPEP provision relating to species election that could affect the pendency of this application.

Applicants have described various embodiments of their invention in the present application in order to lay a suitable foundation for supporting generic claims of meaningful and enforceable scope. For example, a single disclosed embodiment of their invention would under current law only open the possibility that various alleged patentable improvements based on a disclosure of a different embodiment of the basic invention that could be presented by competitors in other patent applications with claims that would be allowable by the USPTO. The result would be that the intended generic and enforceable scope of applicants' present invention would or could be adversely affected.

In good faith, and in a bona fide effort to advance prosecution of this application without such an unacceptable (from applicants' standpoint) adverse effect upon applicants' rights as to amount to a taking of applicants' property to an extent that the subject matter disclosed in the present application must be abandoned by applicants owing to the practical impossibility for applicants to obtain reasonable and enforceable generic patent protection on their invention, applicants suggested a restriction requirement in the Petition as an alternative to the Examiner's species election requirement. By this proposed restriction requirement, four "Groups" for the

subject matter disclosed in the application as filed were presented in the Petition, these Groups being based, just as the Examiner did in the species election requirement, on the Figures presented in the application as filed. The distribution of the Figures among the four proposed Groups is specifically set forth in the Petition (see page 9 thereof). In the Petition, applicants elected Group I from among the thus identified four Groups. The claims of Group I are directed to the paint brush comprising the dissociable but associative combination of a portion and the paint applicator portion; this Group including separate, independent claims to the handle portion and the paint applicator portion, and further including claims directed to modification or features of the handle portion or the paint applicator portion. Thus, applicants believe and submit that, in their response to the Examiner's species election requirement, they have made a species election as duly expressed in the Petition.

As explained in their Petition to Make Special, upon which the USPTO has taken no action, the election of a single genus, as required by MPEP §708.02, was achieved by applicants' proposed self-imposed restriction requirement and their election of their Group I as hereinabove discussed. Applicants respectfully submit that, particularly in light of their above explained Group I selection, their Petition to Make Special fully complies with the Rules of Practice and with the pertinent portions of the MPEP. In good faith, applicants solicit an early and favorable decision on their Petition to Make Special.

For record purposes, it is respectfully noted that an earlier (in point of time) decision on their Petition to Make Special would have avoided any possibility of abandonment of this application through failure to prosecute the present application.

Also for record purposes, it is respectfully noted that in view of the two Petitions that were both timely filed, there was no further appropriate prosecution of the present application that could or even should have been reasonably undertaken by or on behalf of applicants within the six month period following the Office Action.

Accordingly, applicants respectfully request reinstatement of the present application to pending status. Applicants also respectfully request that their two Petitions be granted.

Respectfully submitted,

By   
Michael A. Hierl, Reg. No. 29,807

Dated: October 19, 2004  
OLSON & HIERL, LTD.  
20 North Wacker Drive, 36th Floor  
Chicago, Illinois 60606  
(312) 580-1180  
Attorneys for Applicants

**CERTIFICATE OF MAILING**

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Michael A. Hierl